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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097306,749	05/07/99	MEADE	A-58762-9/RF

HM22/1004

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EXAMINER

ZITOMER, S

ART UNIT

1655

PAPER NUMBER

3

DATE MAILED: 10/04/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/306,749

Applicant(s)  
MEADE et al.

Examiner  
Stephanie Zitomer

Group Art Unit  
1655



☒ Responsive to communication(s) filed on Aug 9, 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**DETAILED ACTION****Double patenting rejections: Obviousness type**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

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9-30-99

1. Claims 28-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,952,172, claims 10-20 of U.S. Patent No. 5,591,578; claims 14-30 of U.S. Patent No. 5,705,348; claims 14-25 of U.S. Patent No. 5,770,369; claims 13-21 of U.S. Patent No. 5,780,234; and claims 1-10, 12-22 of U.S. Patent No. 5,824,723. Although the conflicting claims are not identical, they are not patentably distinct from each other because all of the cited patent claims are drawn to methods for detecting a target nucleic acid sequence which are closely similar to those of instant claims 28-39. Claims 28-39 are generic to claims 10-20 of the '578 patent. The application claims differ from the subsequent patent claims in the presence or configuration of the combination of nucleic acid probe or target sequence and an electrode as electron donor or acceptor. However, it would have been obvious to the skilled practitioner in the art to employ an electrode as an electron donor or acceptor in the claimed method in view of the '578 claims. Differences in configuration, i.e., location of the electron donor and acceptor, would have been known to one of ordinary skill in the art to be variable and discretionary.

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**Provisional double patenting rejection: Obviousness type**

2. Claims 1-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 28-39 of copending Application No. 09/100,507. Although the conflicting claims are not identical, they are not patentably distinct from each other because the '507 application claims are drawn to methods for detecting a target nucleic acid sequence which are closely similar to those of instant claims 28-39. The differences are in the presence or configuration of the combination of nucleic acid probe or target sequence and an electrode as electron donor or acceptor, such as location of the electron donor and acceptor, which would have been known to one of ordinary skill in the art to be variable and discretionary based on experimental design and desired results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Conclusion**

3. **No claim is allowed.** However, the claims are free of prior art and may be placed in condition for allowance by the timely filing of a proper terminal disclaimer.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie Zitomer whose telephone number is (703) 308-3985. The examiner can normally be reached on Monday through Friday from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. The official fax phone number for this Group is (703) 308-4242. The unofficial fax number is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

*S. Zitomer*  
Stephanie W. Zitomer, Ph.D.  
September 30, 1999

STEPHANIE W. ZITOMER  
PRIMARY EXAMINER